UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,710	08/28/2001	Yoichiro Sako	7217/65200	5743

530 7590 05/19/2006	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK	ABRISHAMKAR, KAVEH	
600 SOUTH AVENUE WEST	ART UNIT	PAPER NUMBER
WESTFIELD, NJ 07090	2131	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/940,710	SAKO ET AL.
	Examiner	**Art Unit**	
	Kaveh Abrishamkar	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 March 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 9-23, 35-37, 39-41, 48-52, 55-57, 59-61, 64-65, 80-81, 84-85, 87-89, 92, and 93* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-7,9-23,35-37,39-41,48-52,55-57,59-61,64,65,80,81,84,85,87-89,92 and 93.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2006 has been entered.

2.   Claims 1-7, 9-23, 35-37, 39-41, 48-52, 55-57, 59-61, 64-65, 80-81, 84-85, 87-89, 92, and 93 are currently being considered.

Response to Arguments

Applicant's arguments filed March 3, 2006 have been fully considered but they are not persuasive for the following reasons:

Regarding amended claim 1, the Applicant argues that the Cited Prior Art (CPA), Kuroda et al. (U.S. Patent No. 6,707,774) and Chung et al. (U.S. Patent No. 6,621,933), does not teach that the watermark is added to decoded data that is selected to be subsequently recorded. This argument is not found persuasive. Kuroda teaches embedding a watermark with a copy protection code into video information to make the recording apparatus aware of the copy protection that is applied to the digital video (column 7 lines 36-45). This watermark and copy protection code are used to limit the

number of times that a certain digital video can be recorded. Therefore, it is asserted

that the CPA does teach that a watermark is added to decoded data that is selected to

be subsequently recorded.

Furthermore, the Applicant argues that the CPA does not teach preventing the

insertion of the watermark in decoded data that is selected to be played back. This

argument is not found persuasive. Chung teaches that preventing the watermark

information from being embedded when it is going to be played back (column 9 lines 9-

36). Chung discloses a digital watermark remover which removes the watermark

information if it is embedded in digital video (column 9 lines 34-37), and therefore,

prevents the watermark information from being embedded in the playback data.

Therefore, it is asserted that the CPA does teach preventing the insertion of the

watermark information in decoded data that is selected to be played back.

Therefore, the rejection for the pending claims are maintained as given below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-7, 9-23, 35-37, 39-41, 48-52, 55-57, 59-61, 64-65, 80-81, 84-85, 87-89,

92, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda et

al. (U.S. Patent No. 6,707,774) in view of Chung et al. (U.S. Patent No. 6,621,933).

Regarding claim 1, Kuroda discloses:

A method for outputting data read from a recording medium, comprising the steps of:

decoding the data read from the recording medium (column 2 lines 47-53);

embedding electronic watermark information in the decoded data when the decoded data is selected as data to be subsequently recorded (column 7 lines 36-45).

Kuroda does not explicitly disclose "preventing said electronic watermark information from being embedded in the decoded data when the decoded data selected to be played back." Chung discloses preventing the watermark information from being embedded in decode data when it is going to be output (column 9 lines 9-36, column 12 lines 50-54). Kuroda and Chung are analogous arts in that both are concerned with decoding video/audio information and using watermarks for copy protection. Both also have capabilities for removing the watermark (Kuroda: column 8 lines 22-28). It would have been obvious to one of ordinary skill in the art at the time of invention to remove the watermark prior to outputting it for playback, thereby preventing the embedding of a watermark in playback data, to "prevent degradation of image quality" (Chung: column 12 lines 51-52).

Claim 2 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the steps of determining a type of the recording medium and changing said electronic watermark information based on the type of recording medium (column 7 line 64 – column 8 line 13).

Claim 3 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda discloses:

The method according to claim 2, further comprising the step of embedding electronic watermark information indicating at least a first generation recording is allowed when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 4 is rejected as applied above in rejecting claim 3. Furthermore, Kuroda discloses:

The method according to claim 3, further comprising the step of embedding electronic watermark information indicating recording is prohibited when the recording medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 5 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda discloses:

The method according to claim 2, further comprising the step of embedding electronic watermark information indicating the data read from the recording medium when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 6 is rejected as applied above in rejecting claim 5. Furthermore, Kuroda discloses:

The method according to claim 5, further comprising the step of embedding electronic watermark information indicating the data is copied data when the recording medium is a recordable recording medium (column 19 lines 30-35).

Claim 7 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda discloses:

The method according to claim 2, wherein the type of recording medium is determined by determining whether a pit wobbling portion is present on the recording medium (column 3 line 58 – column 4 line 3).

Claim 9 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the step of embedding electronic watermark information for analog data in the decoded data when the decoded data is output in an analog format (column 7 lines 37 – 54).

Claim 10 is rejected as applied above in rejecting claim 9. Furthermore, Kuroda

discloses:

The method according to claim 9, wherein the decoded data is converted into an

analog signal, and the electronic watermark information for analog data is embedded in

the analog signal (column 7 lines 37–54).

Claim 11 is rejected as applied above in rejecting claim 9. Furthermore, Kuroda

discloses:

The method according to claim 9, further comprising the step of determining the

type of recording medium and changing the electronic watermark information for analog

data based on the type of recording medium (column 7 line 64 – column 8 line 13).

Claim 12 is rejected as applied above in rejecting claim 11. Furthermore, Kuroda

discloses:

The method according to claim 11, further comprising the step of embedding

electronic watermark information including at least first generation recording is allowed

when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 13 is rejected as applied above in rejecting claim 12. Furthermore, Kuroda

discloses:

The method according to claim 12, further comprising the step of embedding electronic watermark information indicating recording is prohibited when the recording medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 14 is rejected as applied above in rejecting claim 11. Furthermore, Kuroda discloses:

The method according to claim 11, further comprising the step of embedding electronic watermark information indicating the data read from the recording medium when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 15 is rejected as applied above in rejecting claim 14. Furthermore, Kuroda discloses:

The method according to claim 14, further comprising the step of embedding electronic watermark information indicating the data is copied data when the recording medium is a recordable recording medium (column 19 lines 30-35).

Claim 16 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the step of embedding electronic watermark information for digital data when the decoded data is output in a digital format and is selected as the data to be subsequently recorded (column 7 lines 37 – 54).

Claim 17 is rejected as applied above in rejecting claim 16. Furthermore, Kuroda

discloses:

The method according to claim 16, further comprising the steps of determining a

type of the recording medium and changing the electronic watermark information for

digital data based on the type of recording medium (column 7 line 64 – column 8 line

13).

Claim 18 is rejected as applied above in rejecting claim 17. Furthermore, Kuroda

discloses:

The method according to claim 17, further comprising the step of embedding

electronic watermark information indicating at least first generation recording is allowed

when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 19 is rejected as applied above in rejecting claim 18. Furthermore, Kuroda

discloses:

The method according to claim 18, further comprising the step of embedding

electronic watermark information indicating recording is prohibited when the recording

medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 20 is rejected as applied above in rejecting claim 17. Furthermore, Kuroda

discloses:

The method according to claim 17, further comprising the step of embedding

electronic watermark information indicating the data read from the recording medium

when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 21 is rejected as applied above in rejecting claim 20. Furthermore, Kuroda

discloses:

The method according to claim 20, further comprising the step of embedding

electronic watermark information including the data is copied data when the recording

medium is a recordable recording medium (column 19 lines 30-35).

Claim 22 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda

discloses:

The method according to claim 1, further comprising the step of not embedding

said electronic watermark information in the decoded data when an operating key is

operated to give a playback command to execute a play back operation in an apparatus

that has located thereon the recording medium (column 6 lines 13 – 28).

Regarding claim 35, Kuroda discloses:

A method for outputting data read from a recording medium, comprising the

steps of:

detecting copy management information from the data read from the recording

medium (column 7 line 64 – column 8 line 13);

determining the detected copy management information (column 7 line 64 –

column 8 line 13); and

embedding electronic watermark information in the data read from the recording

medium according to the determined copy management information when the data read

from the recording medium is selected as data to be subsequently recorded (column 7

line 64 – column 8 line 13).

Kuroda does not explicitly disclose "preventing said electronic watermark information

from being embedded in the decoded data when the decoded data is selected as data

to be played back." Chung discloses preventing the watermark information from being

embedded in decode data when it is going to be output (column 9 lines 9-36, column 12

lines 50-54). Kuroda and Chung are analogous arts in that both are concerned with

decoding video/audio information and using watermarks for copy protection. Both also

have capabilities for removing the watermark (Kuroda: column 8 lines 22-28). It would

have been obvious to one of ordinary skill in the art at the time of invention to remove

the watermark prior to outputting it for playback, thereby preventing the embedding of a

watermark in playback data, to "prevent degradation of image quality" (Chung: column

12 lines 51-52).

4.   Claims 36-37, and 39-41 claim analogous subject matter to the method claims 1-
7, and 9-23 rejected above, and therefore, are rejected following the same reasoning
applied above.

Regarding claim 48, Kuroda discloses:

        An apparatus for playing back a recording medium, comprising:

        a head for reading data from the recording medium (column 7 line 64 – column 8
line 13);

        a decoder for decoding an output signal from said head (column 7 line 64 –
column 8 line 13); and

        an adding unit and a selector unit for embedding electronic watermark
information in the data from said decoder when the data from said decoder is selected
as data to be subsequently recorded (column 7 line 64 – column 8 line 13).

Kuroda does not explicitly disclose "preventing said electronic watermark information
from being embedded in the decoded data when the decoded data is selected as data
to be played back." Chung discloses preventing the watermark information from being
embedded in decode data when it is going to be output (column 9 lines 9-36, column 12
lines 50-54). Kuroda and Chung are analogous arts in that both are concerned with
decoding video/audio information and using watermarks for copy protection. Both also
have capabilities for removing the watermark (Kuroda: column 8 lines 22-28). It would
have been obvious to one of ordinary skill in the art at the time of invention to remove

the watermark prior to outputting it for playback, thereby preventing the embedding of a watermark in playback data, to "prevent degradation of image quality" (Chung: column 12 lines 51-52).

5.   Claims 49-52, 55-57, 59-61, 64-65 claim analogous subject matter to the method claims 1-7, and 9-23 rejected above, and therefore, are rejected following the same reasoning applied above.

Regarding claim 80, Kuroda discloses:

An apparatus for playing back a recording medium, comprising:

a head for reading data from the recording medium (column 7 line 64 – column 8 line 13);

a detector for detecting copy management information from an output signal from said head medium (column 7 line 64 – column 8 line 13); and

an adding unit and a selector unit for adding electronic watermark information according to the detected copy management information to the data read from the recording medium when the data read from the recording medium is selected as data to be subsequently recorded (column 7 line 64 – column 8 line 13).

Kuroda does not explicitly disclose "preventing said electronic watermark information from being embedded in the decoded data when the decoded data is output as playback data." Chung discloses preventing the watermark information from being

embedded in decode data when it is going to be output (column 9 lines 9-36, column 12 lines 50-54). Kuroda and Chung are analogous arts in that both are concerned with decoding video/audio information and using watermarks for copy protection. Both also have capabilities for removing the watermark (Kuroda: column 8 lines 22-28). It would have been obvious to one of ordinary skill in the art at the time of invention to remove the watermark prior to outputting it for playback, thereby preventing the embedding of a watermark in playback data, to "prevent degradation of image quality" (Chung: column 12 lines 51-52).

6.   Claims 81, 84-85, 87-89, and 92-93 claim analogous subject matter to the method claims 1-7, and 9-23 rejected above, and therefore, are rejected following the same reasoning applied above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaveh Abrishamkar whose telephone number is 571-272-3786. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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05/13/2006

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